

ESTTA Tracking number: **ESTTA460445**

Filing date: **03/07/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ZippMark, Inc.
Granted to Date of previous extension	03/28/2012
Address	1105 North Market Street, Suite 1300 Wilmington, DE 19801 UNITED STATES
Attorney information	David S. Elkins, Esq. Squire Sanders (US) LLP 600 Hansen Way Palo Alto, CA 94304 UNITED STATES david.elkins@squiresanders.com, trademark@squiresanders.com, joseph.grasser@squiresanders.com Phone:(650) 856-6500

Applicant Information

Application No	85131965	Publication date	11/29/2011
Opposition Filing Date	03/07/2012	Opposition Period Ends	03/28/2012
Applicant	BLEC, LLC 401 N Tryon Street, Suite 1080 Charlotte, NC 28202 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 2009/05/01 First Use In Commerce: 2009/05/01
All goods and services in the class are opposed, namely: Electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters

Applicant Information

Application No	85131287	Publication date	11/08/2011
Opposition Filing Date	03/07/2012	Opposition Period Ends	
Applicant	BLEC, LLC 401 N Tryon Street, Suite 1080 Charlotte, NC 28202 UNITED STATES		

Goods/Services Affected by Opposition

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Applicant Information

Application No	85092665	Publication date	11/08/2011
Opposition Filing Date	03/07/2012	Opposition Period Ends	
Applicant	BLEC, LLC 401 N Tryon Street, Suite 1080 Charlotte, NC 28202 UNITED STATES		

Goods/Services Affected by Opposition


Class 034. First Use: 2009/05/01 First Use In Commerce: 2009/05/01


All goods and services in the class are opposed, namely: Electronic cigarettes containing tobacco substitutes not for medical purposes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters


Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3299190	Application Date	06/30/2005
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	BLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2005/06/30 First Use In Commerce: 2007/03/16 Lighters not of precious metal		


U.S. Registration No.	3469390	Application Date	06/30/2005
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	BLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2007/04/24 First Use In Commerce: 2007/04/24 Hand-held cigarette and utility lighters of precious metal		

U.S. Registration No.	3606674	Application Date	06/19/2007
Registration Date	04/14/2009	Foreign Priority Date	NONE
Word Mark	BLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2007/10/02 First Use In Commerce: 2007/10/02 FUEL FOR LIGHTERS		

U.S. Registration No.	3680360	Application Date	06/19/2007
Registration Date	09/08/2009	Foreign Priority Date	NONE
Word Mark	BLU		

Design Mark	BLU
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2007/03/16 First Use In Commerce: 2007/03/16 LIGHTERS NOT OF PRECIOUS METAL; LIGHTERS OF PRECIOUS METAL

U.S. Registration No.	3299195	Application Date	07/01/2005
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	ZIPPOBLU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2005/07/01 First Use In Commerce: 2007/03/16 Lighters not of precious metal		

U.S. Registration No.	3464056	Application Date	07/01/2005
Registration Date	07/08/2008	Foreign Priority Date	NONE
Word Mark	ZIPPOBLU		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 014. First use: First Use: 2007/04/24 First Use In Commerce: 2007/04/24 Cigarette and utility lighters of precious metal
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Attachments	78662091#TMSN.jpeg (1 page)(bytes) 78662100#TMSN.jpeg (1 page)(bytes) 77209860#TMSN.jpeg (1 page)(bytes) 77209871#TMSN.jpeg (1 page)(bytes) 78662768#TMSN.jpeg (1 page)(bytes) 78662779#TMSN.jpeg (1 page)(bytes) Zippmark's Combined Notice of Opposition.pdf (7 pages)(3887602 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/david elkins/
Name	David S. Elkins, Esq.
Date	03/07/2012

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos. 85/131965, 85/131287, and 85/092,665
Published in the Official Gazettes of November 8 and November 29, 2011
Marks: **BLU and Design, BLU, and BLU CIGS**

ZIPPMARK, INC.,

Opposer,

v.

BLEC, LLC,

Applicant.

COMBINED NOTICE OF OPPOSITION

ZippMark, Inc., (“Opposer” or “ZippMark”), a corporation organized under the laws of Delaware and located at 1105 North Market Street, Suite 1300, Wilmington, DE 19801, believes it will be damaged by registration of the applied-for trademarks BLU and design, BLU, and BLU CIGS shown in Application Serial Nos. 85/131965, 85/131287, and 85/092,665, and it opposes the same in this Combined Notice of Opposition under Trademark Board Manual for Procedure §305 *et seq.* and 37 CFR §2.104(b). In particular, ZippMark believes that these registrations would give rise a likelihood of confusion with its existing domestic and international BLU registered and common law trademarks in violation of 15 U.S.C. §§ 1052(d) and §43(a).

The grounds for the opposition are as follows:

1. ZippMark and its related company Zippo Manufacturing Co. (“Zippo”), to whom ZippMark licenses its trademarks, offer a variety of cigarette and utility lighters under its world

famous ZIPPO mark and, more recently, under its distinctive BLU trademarks as well as a number of registered marks incorporating the BLU component.

2. Since prior to the filing date of the application opposed herein, ZippMark and Zippo have exclusively distributed, advertised and sold in United States commerce a number of cigarette and utility lighter products and related goods under its BLU trademarks. As a result, ZippMark has common law rights to BLU.

3. ZippMark also owns a number of trademark registrations for BLU whose marks incorporate the BLU component that are registered with the United States Patent and Trademark Office, including without limitation U.S. Registration Nos. 3299190, 3299195, 3464056, 3469390, 3606674, and 3680360 (collectively, the “Zippo BLU Registrations”). See Ex. A (providing TARR records of relevant ZippMark registrations). These registrations cover:

- a. U.S. Registration No. 3299190 for BLU and design for lighters not of precious metal in International Class 034, filed on June 30, 2005 and registered September 25, 2007;
- b. U.S. Registration No. 3469390 for BLU and design for hand-held cigarette and utility lighters of precious metal in International Class 014, filed on June 30, 2005 and registered July 15, 2008;
- c. U.S. Registration No. 3606674 for BLU for fuel for lighters in International Class 004, filed on June 19, 2007 and registered on April 14, 2009;
- d. U.S. Registration No. 3680360 for BLU for lighters not of precious metal and lighters of precious metal in International Class 034, first used in

commerce on March 16, 2007, filed on June 19, 2007, and registered on September 8, 2009;

- e. U.S. Registration No. 3299195 for ZIPPOBLU and design for lighters not of precious metal in International Class 034, filed on July 1, 2005 and registered September 25, 2007; and
- f. U.S. Registration No. 3464056 for ZIPPOBLU and design for cigarette and utility lighters of precious metal in International Class 014, filed on July 1, 2005 and registered July 8, 2008.

These registrations are valid and subsisting and are owned by ZippMark.

4. ZippMark and its related companies have sold significant numbers of Zippo lighters and related products bearing the Zippo BLU marks throughout the United States for several years. ZippMark and its related companies have also extensively advertised and promoted the Zippo BLU marks and products in the United States and throughout the world. In addition, products bearing the BLU mark, as well as the BLU mark itself, have been the subject of press reports.

5. By virtue of such extensive domestic and international sales, advertising and promotion, and press coverage, the Zippo BLU Marks represent extremely valuable goodwill to ZippMark.

6. On July 26, September 16, and September 17, 2010, Applicant filed three applications for registration in International Class 034:

- a. July 26, 2010: Application for BLU CIGS for “electronic cigarettes containing tobacco substitutes not for medical purposes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use

as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters”. This application was assigned Application Serial No. 85/092665.

b. September 16, 2010: Application for BLU for “electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters”. This application was assigned Application Serial No. 85/131287.

c. September 17, 2010: Application for BLU and design for “electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters”.

This application was assigned Application Serial No. 85/131965.

7. Applicant filed each of these applications on the basis of use claimed in United States commerce since May 1, 2009, pursuant to 15. U.S.C. 1152(a).

8. The Examining Attorney initially refused each of the applied-for marks based on ZippMark’s Zippo BLU marks, emphasizing the similarity between the applied-for marks and the Zippo BLU marks would cause confusion as to the source of Applicant’s goods. Applicant attempted to rebut the refusal by arguing that the applied-for marks and the Zippo BLU marks were dissimilar in appearance and connotation, that the goods to which the various marks relate

were dissimilar, and that the purchasers of Applicant's products are sophisticated and not likely to be confused. Upon these arguments, the Examining Attorney revoked the initial refusal.

9. That revocation notwithstanding, the Examining Attorney was initially correct in that Applicant's proposed use of the applied-for marks is indeed likely to (a) cause confusion, mistake or deception with the Zippo BLU marks, and (b) result in the mistaken belief that Applicant or its BLU devices are in some way legitimately connected with, licensed or approved by ZippMark. The applied-for mark is nearly identical in sound, appearance, meaning, connotation and commercial impression to Opposer's existing trade name and trademarks. Moreover, the goods to which the marks relate are similar such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

10. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made commercial use of the applied-for marks before May 1, 2009, the first use date claimed in the applications. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made commercial use of the applied-for marks prior to the stated first use in commerce date of May 1, 2009.

11. Applicant's proposed use of and application to register the applied-for marks is without Opposer's consent or permission.

12. This Opposition is timely, as Opposer has received extensions of time up to and including March 7, 2012, within which to file this Opposition.

13. This Opposition is being filed electronically through ESTTA, pursuant to the Board's rules. The filing fees are being paid through ESTTA.

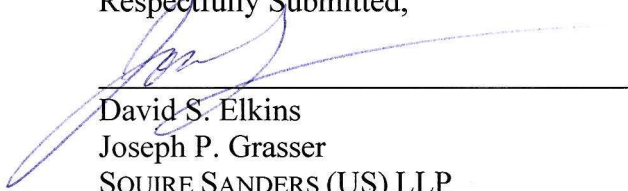
WHEREFORE, Opposer ZippMark, Inc. believes that it would be damaged by the registration by Applicant of the applied-for marks for the goods identified in Application Serial Nos. 85/131965, 85/131287, and 85/092,665, and prays that this Opposition be sustained and that said Applications be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §§ 1052(d).

David S. Elkins and Joseph P. Grasser, members of the State Bar of California and the firm of Squire Sanders (US) LLP, 600 Hansen Way, Palo Alto, California 94304, telephone (650) 856-6500, facsimile (650) 843-8777; and

The U.S. Patent and Trademark Office and the Trademark Trial and Appeal Board hereby are authorized to charge to Squire Sanders (US) LLP's Deposit Account No. 07-1850 the required filing fees plus any deficiencies or additional amounts due for this Notice of Opposition.

Date: March 7, 2012

Respectfully Submitted,



David S. Elkins
Joseph P. Grasser
SQUIRE SANDERS (US) LLP
600 Hansen Way
Palo Alto, California 94304
Telephone: (650) 856-6500
Facsimile: (650) 843-8777

Attorneys for Opposer
ZIPPMARK, INC.

PROOF OF SERVICE BY MAIL

I am a citizen of the United States and employed in Santa Clara County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 600 Hansen Way, Palo Alto, California. I am readily familiar with this firm's practice for collection and processing of correspondence for mailing with the United States Postal Service. On March 7, 2012, I placed with this firm at the above address for deposit with the United States Postal Service a true and correct copy of the within document(s):

COMBINED NOTICE OF OPPOSITION

in a sealed envelope, postage fully paid, addressed as follows:

Blake E. Vande Garde
Hammer & Associates, P.C.
3125 Springbank Lane Suite G
Charlotte, NC 28226
Phone Number: 704-927-0400
Fax Number: 704-927-0485

Following ordinary business practices, the envelope was sealed and placed for collection and mailing on this date, and would, in the ordinary course of business, be deposited with the United States Postal Service on this date.

I declare under penalty of perjury under the laws of the United States that the above is true and correct.

Executed on March 7, 2012, at Palo Alto, California.

By



Joseph P. Grasser